The present application is a continuation of application entitled ELECTRONIC SURFACE MOUNT PACKAGE, Serial No. 08/513,573, filed August 10, 1995, now U.S. Patent No. 5,656,985, issued August 12, 1997 and assigned to the same Assignee as the present application.

This Amendment A is in response to the Office Action mailed October 5, 1999 in which the Examiner rejected Claim 1 under 35 USC 101 as a double patenting rejection. Applicant has cancelled Claim 1 and has added new Claims 2-40 which are not believed to be subject to a double patenting rejection under 35 USC 101. However, applicant is submitting a Terminal Disclaimer and the required fee in view of the expected obviousness-type double patenting issue raised in other related applications being prosecuted by applicant.

The Examiner rejected Claim 1 under 35 USC 102(b)as being anticipated by Renskers.

A claim is anticipated only when a single prior art reference discloses each and every limitation of the claims. Glaxo v. Novopharm, Ltd., 34 USPQ2d 1565, (Fed. Cir. 1995). The disclosure need not be express, but may anticipate by inherency where it would be appreciated by one of ordinary skill in the art. Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746, (Fed Cir. 1991). Applicant submits that a section 102 rejection of the pending claims could not properly stand for the following reasons.

Renskers is for a dual-in-line package (DIP), which is for through-hole PCB (Printed Circuit Board) applications. The terminal pin 32 of the Renskers DIP package is inserted "through" a hole in a PCB, whereas applicant's package is for surface mount packages (SMP) for mounting on or onto the surface of a PCB. "Onto" is defined as on top of; to a position on; upon: the Renskers terminal pins 32 are not mounted onto the surface of a PCB.

Applicant submits that Renskers is not inherently capable of operating as a surface mount package as called for in the pending claims. The terminal pins 38 of Renskers are inserted through a hole in a PCB, and are not suitable for mounting and soldering onto the surface of the PCB. This is believed to be clear to one of ordinary skill in the art. Applicant is submitting Exhibit A which shows the differences between (1) the applicant's (Halo) invention mounted on a PCB (Figure 6 of the present application) and (2) Figure 6 of the Renskers DIP package in which the terminal pins 32 would be inserted through a hole in a PCB.

For this first reason alone, it is submitted that a rejection of the claims under 102 cannot stand. Glaxo, supra.

In addition, applicant's terminal pins are molded within the package side wall, whereas the Renskers terminal pins are inserted and bonded with epoxy within channels formed within the side walls of the Renskers package. Clearly, Renskers does not disclose terminal pins molded within the side wall as called for in applicant's claims. As indicated above, a claim is anticipated only when a single prior art reference discloses each and every limitation of the claims, and hence a 102 rejection of the claims cannot stand. Glaxo, supra.

Using language from Renskers, the Renskers boxes (packages) are finally filled with encapsulant so as to embed, at least, the solder joints of the lead-lead leg connection 42 and the encapsulant cured. There is no such requirement for encapsulating (embedding) the terminal pins or solder posts 12 of the applicant's invention. Rather, applicant's soldered terminal pins or solder posts 12 extend below the bottom of the side wall, whereas the Renskers solder joints 42 are folded back into the cavity and encapsulated.

It is applicant's contention that Renskers solder leg 42 is the only component which could be characterized as a solder post as called for in the claims. The Renskers solder leg 42 is bent

inward into the box so as to have a downward inclination so as to place the solder joints (the solder leg 42) below the level of the sides of the box and inside the box (column 4,lines 10-24 of Renskers). Applicant has amended the claims to more clearly recite that the one end forms a solder post which extends below the bottom of the side wall, as shown in Figure 6 of the drawings (see Exhibit A). The Renskers solder joints are bent backward into the box and do not extend below the bottom of the side wall when placed in a DIP application (the Renskers solder joints 2 are "above" the bottom of the side wall when used in a DIP application). In contrast, applicant's solder posts 12 extend through and below the bottom of the side wall. As shown in Exhibit A, applicant's SMP of Figure 6 of the drawings shows the solder posts extending below the bottom of the side wall when the package is mounted onto a PCB, whereas with Renskers, the solder leads are bent inward into the box and "above" the bottom of the side wall when the Renskers DIP package is placed with the terminal pins inserted through the holes in the PCB in normal DIP package configuration.

For the foregoing reasons, applicant submits that Claims 2-40 patentably distinguishes over Renskers.

Respectfully submitted,

Date: 4/5/99

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